



9-6-05

Attorney's Docket No.: 17111-002002 / 2301B

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JAW/S

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Hubert Köster, Ph.D., et al. Art Unit : 1623
Serial No. : 09/484,484 Examiner : Paul V. Ward
Filed : January 18, 2000
Title : SOLUTION PHASE BIOPOLYMER SYNTHESIS

Mail Stop: Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Dear Sir:

Transmitted herewith is a *Petition for Patent Term Adjustment Pursuant to 37 CFR 1.705(b)* in Response to the Notice of Allowance, mailed June 3, 2005, a check (\$200.00) for the requisite fee under 1.18(e), and a return postcard in connection with the above-captioned patent application.



The Commissioner is hereby authorized to charge the fee for the extension of time and any other fee that may be due in connection with this and the attached papers or with this application during its entire pendency to Deposit Account No. 06-1050. A duplicate of this sheet is enclosed.

Respectfully submitted,

Stephanie Seidman
Reg. No. 33,779

Attorney Docket No. 17111-002002 / 2301B
Address all correspondence to:
Stephanie L. Seidman
Fish & Richardson P.C.
12390 El Camino Real

CERTIFICATE OF MAILING BY "EXPRESS MAIL"
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Date of Deposit September 2, 2005
I hereby certify that this paper is being deposited with the United States Postal "Express Mail Post Office to Addressee" Service under 37 CFR §1.10 on the date indicated above and is addressed to: Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

Stephanie Seidman



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Hubert Köster, Ph.D., et al. Art Unit : 1623
 Serial No. : 09/484,484 Examiner : Paul V. Ward
 Filed : January 18, 2000
 Title : SOLUTION PHASE BIOPOLYMER SYNTHESIS

MAIL STOP: PETITIONS

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

PETITION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR §1.705(b)

Applicant hereby petitions for reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent at time of allowance. The *Notice of Allowance* and *Determination of Patent Term Adjustment* under 35 U.S.C. 154(b) mailed June 3, 2005 states that the Total Patent Term Adjustment at Allowance is "0" days. Reconsideration of the PTA to reasonably increase USPTO Delay from 18 days to 589 days, and increase Total PTA from "0" days to 450 days, is respectfully requested.

The Issue Fee Transmittal along with payment for the above-referenced application is also being filed this date under separate cover to Mail Stop Issue Fee.

The Patent Term Adjustment History in the PAIR system reflects that the U.S. Patent and Trademark Office (PTO) calculated the PTA as follows.

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Date of Deposit: September 2, 2005

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September 2, 2005
 Date of Deposit

Signature

Stephanie Seidman

Typed or Printed Name of Person Signing Certificate

09/09/2005 MAHMED2 00000005 09484484

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200.00 OP

(1) APPL *Response After Ex Parte Quayle Action* due at a three-month date of November 28, 2001, and received by the USPTO on the six-month statutory due date, February 28, 2002. **Applicant agrees with accorded APPL Delay of 92 days;**

(2) APPL *Supplemental Response* after the *Response After Ex Parte Quayle Action* which was subsequently received by the USPTO April 16, 2002 and considered an APPL delay. **Applicant agrees with the APPL Delay of 47 days; and**

(3) PTO mailing of a *Non-Final Rejection*, due at a four-month date of June 28, 2002, and actually mailed on July 16, 2002. **Applicant agrees with the PTO Delay of 18 days.**

Applicant respectfully does not agree with the fact that there are no further calculations noted in the Patent Term Adjustment History, and will demonstrate below that document description entry errors and omissions do exist that require review and reconsideration.

At this point in the PTA History, it can be further observed and agreed that the APPL's two responses and the PTO's two actions, from the October 16, 2002, *Response After Non-Final Action* through the April 23, 2003, *Mail Non-Final Rejection*, were completed within respective due dates for PTA purposes and no delay days were incurred in the PTA History.

Proceeding through the history, the Applicant asserts that in response to the April 23, 2003 *Non-Final Rejection*, an *Amendment and Response* was mailed via Express Mail and received by the PTO on July 11, 2003, together with a *Supplemental Information Disclosure Statement*. For the convenience of the Office, a copy of the Express Mail label, date-stamped postcard, *Transmittal Letter*, and page 1 of the *Amendment and Response* are attached. The complete response is available in the PTO's Image File Wrapper. For this submission there is a duplicate entry for the *Information Disclosure Statement* and an entry for the *Amendment and Response* was omitted. Applicant has tried diligently to get this entry corrected, but to no avail.

Applicant had been advised around the time of this *Response*, July 2003, that the original Examiner, Josephine Young, left the PTO. Despite numerous telephone status inquiries and discussions with the art unit and supervisor, the application was not assigned to newly hired Examiner Paul Ward until November 8, 2004. To compound the Office's delays, this was a traditional paper file, and it became evident that several office actions and

responses were considered lost from the official file. Applicant assisted the Office with file reconstruction by providing file copies on December 23, 2004, and again on March 16, 2005.

As entered, on November 17, 2004, Examiner Ward issued a *Restriction Requirement* in response to Applicant's *Amendment and Response* of July 11, 2003.

A PTO action was due at a four-month date of November 11, 2003 and was not issued until over a (leap) year later on November 17, 2004 for a PTO delay of 372 days which is not reflected in the PTA History. **At a minimum, this PTO Delay of 372 days has been omitted from the PTA calculations.**

Furthermore, the above *Restriction Requirement* was issued erroneously at this point in the prosecution, and it appeared to be based on the original claims and not the pending claims, further evidencing that the PTO file was incomplete at that time. During telephonic exchanges with Examiner Ward, it was agreed that the Requirement was erroneously issued and would be withdrawn. The *Notice of Withdrawn Action*, however, was never mailed despite the entry on November 17, 2004. In fact, there is no evidence of this document in the PTO files/IFW. Regular telephone inquiries, discussions, and electronic correspondence with Examiner Ward and his Supervisor, James Wilson, ensued for months requesting a written withdrawal and new action, eventually concluding with a telephonic interview with Examiner Ward on May 16, 2005. This interview was followed by the May 19, 2005 mailing of an *Examiner Interview Summary*. The *Summary* stated the *Restriction Requirement* was withdrawn and no Applicant response was required as there was nothing outstanding. The valid and true PTO action following the Applicant's July 11, 2003 *Response* was a *Notice of Allowance* mailed June 3, 2005. **As such, this correct response from the PTO constitutes the actual PTO Delay of 571 days**, which includes the PTO Delay of 372 days outlined above.

As a matter of record for the present application which became one of those very problematic cases for the USPTO and Applicant, the *Notice of Allowance* mailed June 3, 2005 was incorrect by not allowing the proper claims, and a *Supplemental Notice of Allowance* was not mailed until two months later, August 9, 2005, without a restart date. In addition, the *Notice of Allowance* was in response to the *Amendment* filed July 11, 2003, further evidencing that there was no contributing delay by Applicant during that time period.

In summation and in consideration of the foregoing evidence regarding the omission of the correct entry for the July 11, 2003 *Response* and subsequent PTO lengthy delay in

responding, Applicant respectfully submits that the current determination of a PTO Delay of 18 days be increased by 571 days to 589 days, and the Total PTA be adjusted to 450 days.

As such, Applicant respectfully requests that the Patent Term Adjustment at Allowance be re-calculated as follows:

- PTO Delay adjustment from 18 days to 589 days
- APPL Delay correct at 139 days
- Total PTA be increased from "0" days to 450 days

With respect to the three-year rule, Applicant is aware that the issuance of this application will be beyond three years from the CPA filed June 14, 2001, however, if the requested reconsideration and PTA adjustment is granted, Applicant acknowledges that a request for additional PTA days will not be added in consideration of the time already earned.

Copies of the following items are provided:

(1) *Transmittal Letter*, page 1 of *Amendment and Response* of July 11, 2003, Express Mail label and date-stamped postcard.

Enclosed is a check for \$200.00 in payment of the petition fee required by 1.18(e). Please apply any other charges or credits to Deposit Account No. 06-1050.

Thank you for your consideration of this Petition. If there should be any questions or additional information required, please call the undersigned.

Respectfully submitted,


Stephanie Seidman

Docket: 17111-002002 / 2301B
Fish & Richardson P.C.
12390 El Camino Real
San Diego, California 92130
Telephone: (858) 678-5070
Facsimile: (858) 678-5099

Reg. No. 33,779



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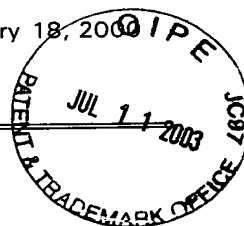
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ORIGIN (POSTAL USE ONLY)				DELIVERY (POSTAL USE ONLY)			
PO ZIP Code 92122	Day of Delivery Next <input type="checkbox"/> Second <input checked="" type="checkbox"/>	Flat Rate Envelope <input type="checkbox"/>		Delivery Attempt	Time	Employee Signature	
Date In 7/11/03	Mo. Day Year 7 11 2003	Postage \$ 13.65		Mo. Day	<input type="checkbox"/> AM <input type="checkbox"/> PM	Employee Signature	
Time In AM <input checked="" type="checkbox"/> PM <input type="checkbox"/>	Military <input type="checkbox"/>	Return Receipt Fee		Delivery Date	Time	Employee Signature	
Weight 11.5 lbs.	Int'l Alpha Country Code	COD Fee	Insurance Fee	Mo. Day	<input type="checkbox"/> AM <input type="checkbox"/> PM	Employee Signature	
No. of Pieces 1	Acceptance Clerk Initials AK	Total Postage & Fees \$ 13.65		<input type="checkbox"/> WAIVER OF SIGNATURE (Postage Only) Additional merchandise insurance is valid if waiver of signature is requested with delivery to be made without obtaining signature of addressee or addressee's agent (if delivery employee judges that article can be left in secure location) and if authorized that delivery employee's signature constitutes valid proof of delivery.			
<input type="checkbox"/> NO DELIVERY <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday				Customer Signature			
CUSTOMER USE ONLY				FEDERAL AGENCY ACCT. NO. OR POSTAL SERVICE ACCT. NO.			
METHOD OF PAYMENT: Express Mail Corporate Acct. No. 1921779				FEDERAL AGENCY ACCT. NO. OR POSTAL SERVICE ACCT. NO.			
FROM: (PLEASE PRINT) FIRM OF HELLER, EHRMAN WHITE & MCAULIFFE LLP 4500 LA JOLLA VILLAGE DR SAN DIEGO CA 92122-1245 24743-2301B				TO: (PLEASE PRINT) COMMISSIONER FOR PATENTS US PATENT AND TRADEMARKS PO BOX 1450 ALEXANDRIA VA 22315-1450			
PRESS HARD. You are making 3 copies.				FOR PICKUP OR TRACKING CALL 1-800-222-1811 www.usps.com			

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WILL BE EVIDENCE OF RECEIPT OF THE FOLLOWING (MAILED ON 07/11/03 BY
EXPRESS MAIL, LABEL # EV 338076347 US):

CLIENT #: 24743-2301B SLS:DLR:MDB:lm
ENCLOSURES: TRANSMITTAL LETTER (in duplicate); AMENDMENT AND
RESPONSE WITH ATTACHMENT TO THE AMENDMENT: MARKED
UP CLAIMS (37 CFR § 1.121) SUPPLEMENTAL INFORMATION
DISCLOSURE STATEMENT (2 pages); PTO-FORM 1449 (1 page);
CITED REFERENCES; CHECK IN THE AMOUNT OF \$180.00; and
RETURN POSTCARD.
APPLICANT: KÖSTER *et al.*
SERIAL NO: 09/484,484 FILING DATE: January 18, 2000
FOR: SOLUTION PHASE BIOPOLYMER SYNTHESIS

PLEASE STAMP HERE (THANK YOU):





IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KÖSTER *et al.*
Serial No.: 09/484,484
Confirmation No.: 9747
Filed: January 18, 2000
For: SOLUTION PHASE BIOPOLYMER
SYNTHESIS
Art Unit: 1623
Examiner: Young, J.

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

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Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450

07/11/03

Date

Tim Chettiath

TRANSMITTAL LETTER

Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith are an amendment responsive to the Office Action mailed on April 23, 2003, a Supplemental Information Disclosure Statement, PTO-Form 1449 (1 page), a check for \$180.00 and cited references for filing in connection with the above-identified application.



The Commissioner is hereby authorized to charge any fee, including any submitted herewith that may be due in connection with this and the attached papers, or with this application during its entire pendency to or to credit any overpayment to Deposit Account No. 50-1213. A duplicate of this sheet is enclosed.

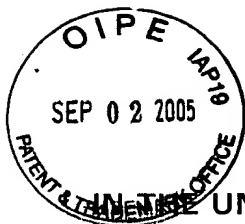
Respectfully submitted,
HELLER, EHRMAN, WHITE & McAULIFFE LLP

By: 

Dale L. Rieger

Registration No. 43,045

Attorney Docket No. 24743-2301B
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UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KÖSTER *et al.*
Serial No.: 09/484,484
Confirmation No.: 9747
Filed: January 18, 2000
For: SOLUTION PHASE BIOPOLYMER
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Art Unit: 1623
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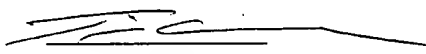
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Alexandria, VA 22313-1450

7/11/03

Date


Tim Chettiath

AMENDMENT AND RESPONSE

Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the Office Action, mailed April 23, 2003, entry of the following amendment and remarks is respectfully requested:

In Claims:

Please cancel claims 9-11, 14-16, 22, 25, 26, 32, and 45 without prejudice or disclaimer. Applicant reserves the right to file divisional and continuation applications directed to any cancelled subject matter. Please replace claims 6, 7, 17, 31, 39, 40 and 48 with the following claims:

6. (Amended Twice) A liquid phase carrier (LPC) that has formula (Id):